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Paper No. 10

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JAN 29 2004

In re Application of:
Vincent K. Lee
Application Serial No.: 09/640,190
Filed: August 17, 2000
For: MOUSE CASING WITH LIQUID ORNAMENT

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600
DECISION
ON PETITION

This is a decision on the petition, filed on January 2, 2003 (the original petition was not matched with the application; a facsimile copy was received October 29, 2003) which is being treated under 37 C.F.R. § 1.181 to withdraw the holding of abandonment (A Notice of Abandonment has not been mailed). No fee is required.

The Petitioner seeks refund for fees paid for filing the extension of time and for filing the Notice of Appeal.

The Petitioner further seeks that actions following the Notice of Appeal be held in abeyance, and seeks adequate time for response to any action issued by the examiner in response to the Amendment and Response After Final Rejection (a copy of which was filed simultaneously with the facsimile copy of the instant petition).

A final Office Action was mailed on July 2, 2002 setting a shortened statutory response period of three months. Applicant timely filed an Amendment in response to said Office action on October 2, 2002 (evidence to this fact is that the original Amendment and Response has recently been matched with the application as well as a duplicate submission of the Amendment and Response received via facsimile on October 29, 2003).

Prior to the examiner having an opportunity to act on the Amendment and Response After Final Rejection, the application apparently was misplaced within the Office. The Office had initiated a file reconstruction process when the original application was found and both applications were merged into a single file wrapper.

37 CFR § 1.135 states: Abandonment for failure to reply within time period.

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment [emphasis added].

MPEP §1206 states: TIME FOR FILING APPEAL BRIEF

37 CFR 1.192(a) provides 2 months from the date of the notice of appeal for the appellant to file an appeal brief. In an ex parte reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c). See also MPEP § 2274.

The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the notice of appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2 month time period is measured. See MPEP § 512. However, 37 CFR 1.192(a) alternatively permits the brief to be filed "within the time allowed for reply to the action from which the appeal was taken, if such time is later." These time periods may be extended under 37 CFR 1.136(a), and if 37 CFR 1.136(a) is not available, under 37 CFR 1.136(b) for extraordinary circumstances.

In the event that the appellant finds that he or she is unable to file a brief within the time period allotted by the rules, he or she may file a petition, with fee, to the Technology Center (TC), requesting additional time under 37 CFR 1.136(a). Additional time in excess of 5 months will not be granted unless extraordinary circumstances are involved under 37 CFR 1.136(b). The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

The fact that applicant filed an Amendment and Response after Final Rejection timely, did not stop the running of the statutory period for reply to the final rejection. Applicant was required to file a petition for extension of time and Notice of Appeal, or other appropriate action, in order to keep the application in pending status. There was no record of these items within the contents of the file.

In response to a telephone call on October 29, 2003 from Dwayne Bost at the U.S. PTO, Applicant provided to the Office via facsimile transmission, a copy of a Notice of Appeal, a Petition For Extension Of Time and a Post Card receipt. The Post Card receipt itemized both Petition and Notice of Appeal and also bore the date stamp receipt within the U.S. PTO of January 2, 2003.

M.P.E.P. § 503 states:

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. [emphasis added]

Although the original Petition for Extension of Time and Notice of Appeal were not matched with the file, the postcard evidences timely filing of those documents. Appellant's brief was due two months from the Notice of Appeal or within the time allowed for reply to the action from which the appeal was taken. Extensions of time were available under 37 C.F.R §1.136(a).

Appellant's failure to timely file an Appeal Brief, dismissed the Appeal. A dismissed Appeal with all claims rejected would have resulted in the abandonment of an application.

Applicant however, had timely filed an Amendment and Response after Final Rejection which, for unfortunate reasons, was not brought to the examiner's attention for consideration. The Amendment and Response have since been given to the examiner to determine if the submissions overcome the rejections of record. The examiner's review of the Amendment and Response are deemed to overcome the rejections of record. Therefore, the Amendment and Response will be entered into the application and hence, the holding of abandonment is withdrawn.

Accordingly, the petition to withdraw holding of abandonment is **GRANTED**.

The instant petition was considered under 37 C.F.R. §1.181 which does not require a fee. Accordingly the \$130.00 petition fee charged to Applicant's deposit account has been credited back to the deposit account.

Petitioner's request for refund of the fees submitted for filing the extension of time and for filing the Notice of Appeal with the subject petition is noted. If Petitioner desires refund of these fees, a separate petition under 37 C.F.R. §1.183 requesting a waiver or suspension of the rules would be required. Hence, Petitioner's request for a refund of the fees submitted for the extension of time and the Notice of Appeal is **DISMISSED**.

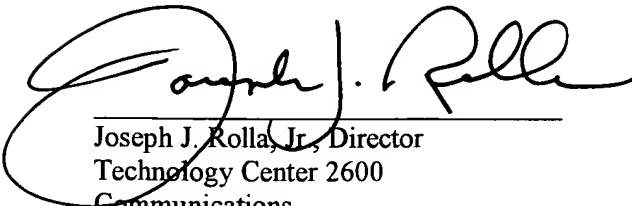
A protest has been filed in the application (paper No. 5, August 2, 2002) in duplicate.

MPEP § 1.291 Protests by the public against pending applications states in part:

- (a) Protests by a member of the public against pending applications will be referred to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file if:
 - (1) The protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; and
 - (2) The protest is either served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.

Accordingly, the application will be forwarded to the examiner for consideration of the protest and for further action as appropriate.

The Petitioner's request for adequate time to respond to any action issued by the examiner in response to the Amendment and Response After Final is hereby considered **MOOT**.



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